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PATENT
P53821C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

RICHARD G. HYATT Jr.

Serial No.: 08/720,070 Examiner: BARRETT, SUZANNE

Filed: 27 September 1996 Art Unit: 3653

For: ELECTROMECHANICAL CYLINDER PLUG

RENEWED PETITION UNDER 37 C.F.R. §1.181

Mail Stop: Petitions Office **Paper No. 98**
Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision on Petition mailed 16 August 2007, entry of this Renewed Petition Under 37 C.F.R. §1.181 is respectfully requested.

Applicant respectfully petitions from the inadvertent failure of the Examiner stated in Paper No. 20070220 to enter Applicant's Amendment timely filed on the 30th of November 2006, as reasons therefor, states that:

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that, on 16 October 2007, this correspondence is being facsimile transmitted to the U.S. Patent & Trademark Office **(Facsimile No. 571-273-8300)**

Total 14 sheets

For Robert E. Bushnell
Reg. No. 27,774

Folio: P53821C
Date: 10/16/07
I.D.: REB/kf

STATEMENT OF FACTS

1. Applicant's above captioned U.S. patent application were subjected by Examiner Diane Boucher to an election under 35 U.S.C. §121 and 37 CFR §1.146 between what the examiner identified as nine (9) species, in a written Office action dated on the 17th of September 1997.
2. On the 13th of June 2003, a Final Office action (Paper No. 53) was issued.
3. In Paper No. 53, pending claims 46 through 52 were rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable over the Examiner's proposed combination of Gokcebay, U.S. Patent No. 5.552.777, modified by Thordmark *et al.*, U.S. Patent No. 5.542.274 and Naveda, U.S. Patent No. 4.416.127.
4. No rejection of claim 53 was made by Paper No. 53.
5. Throughout the course of the examination of the above-captioned application, pending claims 46 through 53 had never been subjected to a rejection under the doctrine of obviousness-type double patenting.
5. On the 3rd of December 2003, a Notice of Appeal (Paper no. 58) was timely filed.
6. In an Examiner's Answer mailed on the 27th of September 2006 (an unnumbered Paper), the Examiner made a non-standard imposition of a new ground of rejection under 37 CFR §41.39(a)(2) of pending claims 46 through 53 under the doctrine of obviousness-type double patenting over claims 17 through 23 of Applicant's co-pending application 10/440,308.
7. The non-standard imposition of a new ground of rejection under 37 CFR §41.39(a)(2) of pending claims 46 through 53 under the doctrine of obviousness-type double patenting over claims 17 through 23 of Applicant's co-pending application 10/440,308 was set forth in a footnote, appended to the subheading "**(10) Grounds Of Rejection**", and in its

entirety, that footnote stated:

> "It was newly discovered that co-pending application 10/440,308 includes claims 17-23 which correspond to claims 46-53 of the instant application. However, since this would be a provisional application, new grounds of rejection are not presented at this time."

8. The Examiner's Answer listed this obviousness-type double patenting rejection of claims 46 through 53 in that section of the Examiner's Answer identified as the *Grounds of Rejection*, but appended a footnote to this ground as a caveat stating that "new grounds of rejection are not presented at this time."

9. Prior to the 27th of September 2006, pending claims 46 through 53 had never been subjected to a rejection under the doctrine of obviousness-type double patenting over claims 17 through 23 of Applicant's co-pending application 10/440,308.

10. Prior to the 27th of September 2006, no pending claim had been subjected to a rejection under the doctrine of obviousness-type double patenting over claims 17 through 23 of Applicant's co-pending application 10/440,308.

11. Subsequent to the first presentation in the *Grounds of Rejection* of the newly presented rejection of claims 46 through 53 under the doctrine of obviousness-type double patenting over claims 17 through 23 of Applicant's co-pending application 10/440,308, the Examiner's Answer devoted all of pages 14, 15 and 16 to exhaustively arguing in support of the rejection of claims 46 through 53 under the doctrine of obviousness-type double patenting over claims 17 through 23 of Applicant's co-pending application 10/440,308 in conjunction with a double patenting rejection of other claims over Applicant's issued divisional application as U.S. Patent No. 6.564.601.

12. No other ground of rejection was argued by the Examiner on pages 14, 15 and 16 of the Examiner's Answer, except the newly imposed rejection of claims 46 through 53 under the doctrine of obviousness-type double patenting over claims 17 through 23 of Applicant's co-pending application 10/440,308.

13. On the 27th of November 1006, Applicant pursuant to 37 CFR §1.193 and 37 CFR §41.39(b), (*i*) requested that prosecution be re-opened before the primary examiner, (*ii*) prepared and filed an Amendment directed to the new ground of rejection, and (*iii*) requested that Applicant's Amendment be entered and considered by the primary examiner.

14. On the 27th of February 2007, the Examiner issued Paper No. 20070220 entitled *Advisory Action After the Filing of an Appeal Brief*, "indicating that the amendment would not be entered due to the fact that the Examiner's Answwer clearly states that 'no new grounds of rejection are presented (see footnote 1, page 4 of the Examiner's Answer).'"[1] asserted that,

> "under 37 CFR §41.44(b), a reply brief should not include any new amendment. Since this response includes and amendment, it is non-compliant under 41.44(b). Applicant's 2 month period for response (via reply brief) has expired and the file is being forwarded to the BPAI for docketing of appeal."

15. The *Decision On Petition Under 37 CFR §1.181*, made a factual determination that,

> "[a]fter reviewing appellant's amendment and arguments, the advisory action of February 27, 2007, and the Examiner's Answer of September 27, 2006, it has been determined that the indication in footnote 1

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[1] *Decision On Petition Under 37 CFR §1.181*, page 1.

> on page 4 of the answer is not a new grounds of rejection."

16. The *Decision On Petition* concluded that,

> "[f]or the above reasons, it is believed that the statement in footnote 1 on page 4 of the Examiner's Answer is neither considered as being a new ground of rejection nor allowed to be in an Examiner's Answer. Therefore, the amendment filed on November 30, 2006 will not be entered, the applicant's request will not be entered and the application will not be reconsidered by the examiner under the provisions of 37 CFR 1.112, prosecution will not be reopened before the primary examiner in conformity with 37 CFR 41.39(b)(1), [and] the examiner will not be directed to enter and consider applicant's amendment filed on November 30 2006 pursuant to 37 CFR 41.39(b) .... ."

17. The *Decision On Petition* made no correction of the Examiner's Answer, made no alteration to the Examiner's Answer, and did not remove the statement presented in that section of the Examiner's Answer identified as the *Grounds of Rejection*, where the Examiner imposed a new ground of rejection under 37 CFR §41.39(a)(2) of pending claims 46 through 53 under the doctrine of obviousness-type double patenting over claims 17 through 23 of Applicant's co-pending application 10/440,308.

REMARKS

Applicant respectfully petitions from denial set forth in the *Decison On Petition* of the Director pursuant to 37 C.F.R. §1.181(a)(1) which sustained the refusal of the primary examiner to enter and consider Applicant's Amendment timely filed on the 30th of November 2006 as is indicated by the Examiner in the *Advisory Action After the Filing of an Appeal Brief* issued on the 27th of February 2007 (Paper No. 20070220), andfrom the refusal of the Director to exercise his authority pursuant to 37 C.F.R. §1.181(a)(3) to invoke the Supervisory of Authority of the Director, and to direct entry of Applicant's Amendment timely filed on the 30th of November 2006, in view of the foregoing statement of facts.

In Paper No. 20070220, the *Advisory Action After the Filing of an Appeal Brief,* the Examiner asserted that,

> "under 37 CFR §41.44(b), a reply brief should not include any new amendment. Since this response includes and amendment, it is non-compliant under 41.44(b). Applicant's 2 month period for response (via reply brief) has expired and the file is being forwarded to the BPAI for docketing of appeal."

This action is improper under the rules of *Practice Before The Board Of Patent Appeals And Interferences*, 37 CFR §41.1 through 37 CFR §41.208.

First, the Examiner's refusal to enter Applicant's Amendment is erroneously premised upon "37 CFR §41.44(b)." In point of fact, no "37 CFR §41.44(b)" has ever been written, or been published in the *Federal Register* for public comments, or been adopted by the Director. In short, nothing in 37 CFR §41.1 through 37 CFR §41.208 gives the Examiner authorization to deny entry of Applicant's Amendment.

Second, under the rules of appellate practice in effect when Applicant's *Notice of Appeal* and *Appeal Brief* was filed, 37 CFR §1.197(a)(2) expressly stated that "An examiner's answer **must not** include a new ground of rejection. Moreover, under the

subsequently adopted rules, 37 CFR §41.39(a)(2) provides that, "[a]n examiner's answer may include a new ground of rejection." This grace according to the examiner's answer is balanced by 37 CFR §41.39(b), which provides that:

> "If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection: (1) Reopen prosecution. Request that the prosecution be reopened before the primary examiner by filing a reply under §1.111 of this title with or without amendment or submission of affidavits (§§1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application ... will be reconsidered by the examiner under the provisions of §1.112 of this title."

This first option was timely exercised by Applicant in the written Amendment timely filed on the 30th of November 2006.

While Applicant submits that it is unconventional practice for a new ground of rejection to be presented in a footnote, and that it is also not standard practice both under 37 CFR §1.104(c)(1) and under 37 CFR §41.39(a)(2) to accompany a newly presented ground of rejection with a statement that "since this would be a provisional application, new grounds of rejection are not presented at this time", it should be noted that it is mandatory under 37 CFR §41.39(b) of the newly adopted rules of appellate procedure that the Applicant respond to the presentation of a "new ground" of rejection in the examiner's answer, regardless of how unconventional the presentation of that new ground of rejection may be; this imposition upon the Applicant is not tempered by whether the Examiner's presentation of a new ground of rejection is proper or improper in format, or by whether the examiner has precisely or correctly *designated* as a new ground of rejection. In point of fact, nothing in 37 CFR §41.1 through 37 CFR §41.208 describes

how a new ground of rejection must be designated by the examiner's answer, and the controlling authority, 37 CFR §1.104(c)(1), places no limit upon the style, format or mode by which an examiner may express how a claim which the examiner has "considered unpatentable will be rejected."[2]

The guidance provided by the *Manual of Patent Examining Procedure*, 8th Edition, Revision 5 (April 2007) simply requires that the new ground of rejection "in an answer must be ... prominently identified in the *Grounds of Rejection to be Reviewed on Appeal.*" *MPEP* §1207.03(I)(B). In point of fact, the Examiner's Answer does not contain a section which is precisely identified as a *Grounds of Rejection to be Reviewed on Appeal*, but instead contains a section which is simply identified as *(10) Grounds of Rejection*, followed by a foot note which proclaims that "It was newly discovered that co-pending application 10/440.308 includes claims 17-23 which correspond to claim 46-53 of the instant application. However, since this would be a provisional rejection, new grounds of rejection are not presented at this time."

In substance, that section of the *Examiner's Answer* identified as *(10) Grounds of Rejection* does contain "a rejection designated as a new ground of rejection", despite the Examiner's disclaimer located in a footnote, that "new grounds of rejection are not presented at this time." Moreover, beginning on page 13 of the Examiner's Answer, the Examiner exhaustively argues throughout pages 14, 15 and 16 that the newly presented obviousness double patenting rejection over Applicant's co-pending application 10/440.308 while concurrently arguing in support of a double patenting rejection of other claims over Applicant's issued divisional application as U.S. Patent No. 6.564.601. Applicant submits that a caveat presented in the Examiner's footnote does not negate the presentation of a **new ground** of rejection argued in pages 14, 15 and 16, even when that **new ground** is disguised by combining the argument newly made with another rejection of similar nature. Combining the newly presented obviousness double patenting rejection

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[2] 37 CFR §1.104(c)(1).

of claims 46 through 53 over Applicant's co-pending application 10/440.308 while concurrently arguing in support of a double patenting rejection of other claims over Applicant's issued divisional application as U.S. Patent No. 6.564.601 does not negate the overt presentation by the Examiner of a new ground of rejection of claims 46 through 53 to the Board of Patent Appeals and Interferences.

The fact remains that:

1. The *Examiner's Answer* presents a new ground of rejection of that is, despite the footnoted disclaimer to the contrary, in the *Grounds of Rejection* of the newly presented rejection of claims 46 through 53 under the doctrine of obviousness-type double patenting over claims 17 through 23 of Applicant's co-pending application 10/440.308, and more significantly, extensively presents written arguments in support of the in the *Grounds of Rejection* by arguing for the propriety of the rejection of claims 46 through 53 under the doctrine of obviousness-type double patenting over Applicant's co-pending application 10/440.308 concurrently with the rejection of other claims under the doctrine of obviousness-type double patenting over Applicant's issued divisional Patent No. 6.564.601.
2. It is mandatory under 37 CFR §41.39(b) of the newly adopted rules of appellate procedure that the Applicant respond to the presentation of a "new ground" of rejection in the examiner's answer, and this mandatory imposition upon the Applicant to respond to the presentation of a *new ground* of rejection is not tempered by whether the Examiner's presentation of a new ground of rejection is proper or improper, or by whether the examiner has precisely or correctly *designated* as a new ground of rejection.

Nothing in 37 CFR §41.39(b) ameliorates the obligations of the Applicant to respond in

one of the two alternatives provided by 37 CFR §41.39(b). Applicant has correctly prepared and timely filed an Amendment which complies with the requirements of 37 CFR §41.39(b); that Amendment should be entered. Furthermore, that Amendment requested that "prosecution be reopened before the primary examiner", and under 37 CFR §41.39(b)(1), Applicant's "request ... **will be entered** and the application ... **will be reconsidered** by the examiner under the provisions of §1.112 ... ." The Examiner's use of a disclaimer in a footnote appended to the Examiner's *Grounds of Rejection* does not relieve Applicant from the requirement of 37 CFR §41.39(b); the Applicant has fully complied, and the remainder of 37 CFR §41.39(b) which states that Applicant's "request ... will be entered and the application ... will be reconsidered by the examiner ..." must therefore be executed by the Examiner.

CONCLUSION

At issue here is the very first portion of the Examiner's Answer denominated by the subheading "**(10) Grounds Of Rejection**", which, in its entirety, states:

> "It was newly discovered that co-pending application 10/440,308 includes claims 17-23 which correspond to claims 46-53 of the instant application. However, since this would be a provisional application, new grounds of rejection are not presented at this time."

The denial of relief to Applicant by the *Decision On Petition* is improper because the Director of the Tech Center failed:

- To consider that Applicant's *Notice of Appeal* was timely filed almost three (3) years ago on the 8th of November 2004, and that the threshold instruction for construction of the rules of practice before the Board given by Administrative Law Judge Jeffery Nase in 37 CFR §41.1(b) suggests that "[t]he provisions of part 41 shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding before the Board."
- To consider that the Examiner's assertion that "[i]t was ***newly*** discovered that co-pending application 10/440,308 includes claims 17-23 which correspond to claims 46-53 of the instant application" is not creditable because both the above-captioned application and Serial No. 10/440,308 have been assigned to the same Examiner for many years.
- To consider that nothing in 37 CFR §41.1 through 37 CFR §41.208 describes how a new ground of rejection must be designated by an examiner's answer.
- To consider that the controlling authority defining the process of rejection claims, 37 CFR §1.104(c)(1), places no limit upon the style, format or mode by which an examiner may express how a claim which an examiner has

"considered unpatentable will be rejected."[3]

- To consider that the Examiner's Answer exhaustively argues throughout pages 14, 15 and 16 that the newly presented obviousness double patenting rejection over Applicant's co-pending application 10/440.308 intertwined with arguments in support of a double patenting rejection of other claims over Applicant's issued divisional application as U.S. Patent No. 6.564.601.
- To consider that the claims of Applicant's above captioned U.S. patent application were subjected by Examiner Diane Boucher to an election under 35 U.S.C. §121 and 37 CFR §1.146 between what the examiner identified as nine (9) species, in a written Office action dated on the 17th of September 1997.
- To consider that citation of Applicant's co-pending application 10/440.308 against the above-captioned application is forbidden under 35 U.S.C. §121, regardless of what claims were pending when the requirement for an election of species was imposed on the 17th of September 1997.
- To consider that 37 CFR §41.39(b) of the newly adopted rules of appellate procedure imposes a mandatory requirement that the Applicant respond to the presentation of a "new ground" of rejection in the examiner's answer, and this mandatory imposition upon the Applicant to respond to the presentation of a *new ground* of rejection is not tempered by whether the Examiner's presentation of a new ground of rejection is proper or improper, or by whether the examiner has precisely or correctly *designated* as a new ground of rejection.
- To consider that Applicant correctly prepared and timely filed an Amendment which complies with the requirements of 37 CFR §41.39(b);

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[3] 37 CFR §1.104(c)(1).

that Amendment should be entered. Applicant correctly requested that "prosecution be reopened before the primary examiner", and under 37 CFR §41.39(b)(1), Applicant's "request ... **will be entered** and the application ... **will be reconsidered** by the examiner under the provisions of §1.112 ... ."

- To consider that denial of any opportunity for Applicant to respond to an issue of obviousness double patenting newly raised in the Examiner's Answer, by using one of the two alternatives provided to an applicant by 37 CFR §41.39(b).

These omissions suggest that the reasoning of the *Decision On Petition* is unsupported by the overwhelming evidence of record, and is therefore unsustainable.

RELIEF REQUESTED

In view of the above, the Commissioner is respectfully requested to:

A. Refuse to sustain the refusal of the Examiner to enter and consider Applicant's Amendment filed on the 30th of November 2006;

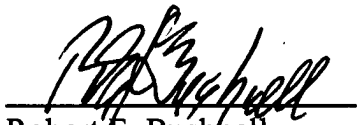
B. Direct that Applicant's "request ... **will be entered** and the application ... **will be reconsidered** by the examiner under the provisions of §1.112 ...";

C. Direct that "prosecution be reopened before the primary examiner" in conformity with 37 CFR §41.39(b)(1) and with the Applicant's;

D. Direct the Examiner to enter and consider Applicant's Amendment filed on the 30th of November 2006 pursuant to 37 CFR §41.39(b); and

E. Grant such other and further relief as justice may require.

Respectfully submitted,



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